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EXAMINER

MAURO JR, THOMAS J

ART UNIT PAPER NUMBER

2143

DATE MAILED: 05/21/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,348

Applicant(s)

SCHNEIDER, ERIC

Examiner

Thomas J. Mauro Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 are pending and are presented for examination. A formal action on the merits of claims 1-20 follows.

Drawings

2. The drawings are objected to because they fail to show the necessary textual labels of the various features in Figure 1. Each element in Figure 1 must be labeled as described in the specification. Specifically, please provide textual labels, as described in the specification, for items 100, 112, 116, 122, 124 and 150. A descriptive textual label for each numbered element in the figures would be necessary for one to fully understand the figures without substantial analysis of the detailed specification. Any structural detail that is of sufficient importance to be described should be shown and properly labeled in the drawings. See 37 CFR 1.84(n) and (o). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 14-15 and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuei (U.S. 6,654,779).

With respect to claim 1, Tsuei teaches a method for delivering by a delivery service, a first message from a sender having a sender address to a recipient having a first recipient address comprising the steps of:

receiving the first message by the delivery service [Tsuei -- **Figure 4 and Col. 5 lines 2-3 – Message is transmitted over Internet and is received by recipient ISP, i.e. delivery service**];

determining that the first message is undeliverable to the first recipient address [Tsuei -- **Figure 4 and Col. 5 lines 4-7 and lines 15-33 – Recipient ISP checks to see if the username part of the e-mail address exists on the ISP server. If none exists, message is undeliverable**];

adding access information of a locator service to the first message [Tsuei -- **Col. 6 lines 16-29 and Col. 7 lines 33-46 – Upon address being undeliverable, ISP server queries E-mail Address Management System, i.e. locator service, to determine if new address exists for the intended person. If one exists, new e-mail address, i.e. access information, is added to the first message**]; and,

providing the first message having said access information to the sender address [Tsuei -- **Figure 4 and Col. 7 lines 43-46 – Reply is sent by the server to the sender containing the access information, i.e. new e-mail address**].

With respect to claim 2, Tsuei further teaches wherein said access information is one of a machine readable code, telephone number, postal address, e-mail address, domain name, and URI and assists the sender in locating the recipient [Tsuei -- **Col. 7 lines 45-46 – Access information returned is the recipient's new e-mail address**].

With respect to claim 3, Tsuei further teaches wherein the sender address and the first recipient address is an e-mail address and the delivery service is an e-mail messaging system [Tsuei -- **Col. 4 lines 47-59 – E-mail messages are sent from a sender address to a recipient address, i.e. email addresses, via an ISP, i.e. delivery service running mail server software, etc.**].

With respect to claim 4, Tsuei further teaches wherein said step of determining that the first message is undeliverable further includes the step of determining that said recipient e-mail address is unknown [Tsuei -- **Col. 5 lines 4-9 and 15-21 – ISP checks to see if the mailbox specified in the username portion of the e-mail address exists at the ISP. If it does not exist, e-mail address is unknown to server**].

With respect to claim 14, Tsuei further teaches wherein the recipient includes a plurality of e-mail addresses and said step of determining that the first message is undeliverable further includes the step of determining that at least one e-mail address is unknown from said plurality of e-mail addresses [Tsuei -- Col. 5 lines 2-33 – **Once a message arrives at an ISP over the Internet, each e-mail address is checked to determine if the mailbox specified in the username portion exists at the ISP. Therefore, if one username of the address does not exist at the ISP, the message is undeliverable because the user is unknown**].

With respect to claim 15, Tsuei further teaches generating a second recipient address corresponding to the first recipient address [Tsuei -- Col. 7 lines 9-14 and lines 33-43 – **New e-mail address, i.e. second recipient address, is correlated to the old e-mail address, i.e. first recipient address, and used to manually or automatically route message that was undeliverable to the recipient's new e-mail address**].

With respect to claim 19, Tsuei teaches an apparatus for delivering by a delivery service, a first message from a sender having a sender address to a recipient having a first recipient address comprising:

a processor and a memory in operative association with said processor [Tsuei -- Figure 1, Col. 4 lines 34-46 and Col. 6 lines 20-22 – **Computers and servers inherently contain processors and memory to carry out instructions and programs**];

means for receiving the first message by the delivery service [Tsuei -- **Figure 4 and Col. 5 lines 2-3 – Message is transmitted over Internet and is received by recipient ISP, i.e. delivery service**];

means for determining that the first message is undeliverable to the first recipient address [Tsuei -- **Figure 4 and Col. 5 lines 4-7 and lines 15-33 – Recipient ISP checks to see if the username part of the e-mail address exists on the ISP server. If none exists, message is undeliverable**];

means for adding access information of a locator service to the first message [Tsuei -- **Col. 6 lines 16-29 and Col. 7 lines 33-46 – Upon address being undeliverable, ISP server queries E-mail Address Management System, i.e. locator service, to determine if new address exists for the intended person. If one exists, new e-mail address, i.e. access information, is added to the first message**]; and,

means for providing the first message having said access information to the sender address [Tsuei -- **Figure 4 and Col. 7 lines 43-46 – Reply is sent by the server to the sender containing the access information, i.e. new e-mail address**].

With respect to claim 20, Tsuei teaches a computer program product for delivering by a delivery service, a first message from a sender having a sender address to a recipient having a first recipient address comprising:

means for retrieving content from a computer network [Tsuei -- **Col. 5 lines 2-3 and Col. 7 lines 36-43 – ISP server retrieves e-mail message from network and also retrieves new addresses by searching remote location on network for address changes**];

means for receiving the first message by the delivery service [Tsuei -- **Figure 4 and Col. 5 lines 2-3 – Message is transmitted over Internet and is received by recipient ISP, i.e. delivery service**];

means for determining that the first message is undeliverable to the first recipient address [Tsuei -- **Figure 4 and Col. 5 lines 4-7 and lines 15-33 – Recipient ISP checks to see if the username part of the e-mail address exists on the ISP server. If none exists, message is undeliverable**];

means for adding access information of a locator service to the first message [Tsuei -- **Col. 6 lines 16-29 and Col. 7 lines 33-46 – Upon address being undeliverable, ISP server queries E-mail Address Management System, i.e. locator service, to determine if new address exists for the intended person. If one exists, new e-mail address, i.e. access information, is added to the first message**]; and,

means for providing the first message having said access information to the sender address [Tsuei -- **Figure 4 and Col. 7 lines 43-46 – Reply is sent by the server to the sender containing the access information, i.e. new e-mail address**].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-7 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei (U.S. 6,654,779), as applied to claims 3, 5, 6 and 12 above respectively, in view of Zoken (U.S. 5,944,787).

Regarding claim 5, Tsuei teaches the invention substantially as claimed, as aforementioned in claim 3 above, but fails to explicitly teach parsing contact information from said message, generating a URI and adding the generated URI to the message. Zoken, however, discloses a system and method which parses an e-mail for contact information and searches an electronic white pages database automatically, thereby requiring that a URI query be generated in order for the system to automatically perform the search [**Zoken -- Col. 2 lines 53-58, Col. 3 lines 19-25 and Col. 4 lines 8-9**].

While Zoken does not explicitly teach adding said URI to the message, it was shown above in Tsuei that information, i.e. an e-mail address link, can be added to a message. Therefore, it would have been well known and obvious for one of ordinary skill in the art to add information, i.e. the URI, to the message, rather than perform the search automatically, in order to alleviate the processing burden on the server by presenting the user with the URI and allow them to decide whether or not to perform the query.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the parsing of contact information, generation of a URI and adding the URI a message, as taught by Zoken into the invention of Tsuei, in order to allow the user to search postings and public information to identify user information, i.e. a postal address [**Zoken -- Col. 1 lines 67-Col. 2 lines 1-10**].

Regarding claim 6, Tsuei-Zoken teach the invention substantially as claimed, as aforementioned in claim 5 above, further including the steps of generating a second message having said generated URI [**Zoken -- Col. 3 lines 17-27 – Parsed contact information from e-mail message, i.e. sender name or address, is used to search electronic white pages, which requires that a URI containing the query information be generated to allow the system to access the database and perform the search**], and providing said second message to the sender address [**Tsuei Col. 7 lines 45-56 – ISP generates second message to notify user or recipient's new e-mail address**].

Regarding claim 7, Tsuei-Zoken teach the invention substantially as claimed, as aforementioned in claim 6 above, wherein providing said second message to the sender address assists the sender in locating the recipient [**Zoken -- Col. 3 lines 23-36 – By providing information of a postal address or information that would lead the user to finding the postal address of a user, this would assist the sender in locating the recipient by identifying the geographic locale of the recipient, thus putting them closer to finding the recipient**].

Regarding claim 10, Tsuei-Zoken teach the invention substantially as claimed, as aforementioned in claim 5 above, wherein said generated URI includes a query portion having said parsed contact information [**Zoken -- Col. 3 lines 17-27 – Parsed contact information from e-mail message, i.e. sender name or address, is used to search electronic white pages,**

which requires that a URI containing the query information be generated to allow the system to access the database and perform the search].

Regarding claim 11, Tsuei-Zoken teach the invention substantially as claimed, as aforementioned in claim 5 above, wherein said parsed contact information includes a postal address [**Zoken -- Col. 3 lines 17-27 – Sender's name and/or address is parsed from contact information in e-mail message**] or the first recipient address [**Tsuei -- Col. 7 lines 36-41 – Old e-mail address, i.e. first recipient address, is used as a search query to find new e-mail address in EAMS database**].

Regarding claim 12, Tsuei-Zoken teach the invention substantially as claimed, as aforementioned in claim 5 above, wherein said generated URI [**Zoken -- Col. 3 lines 19-25 – In order for electronic white pages database to be searched by server, URI is required to be generated to access database site/location and perform query automatically**] corresponds to the first recipient address [**Tsuei -- Col. 7 lines 36-41 – Old e-mail address, i.e. first recipient address, is used as a search query to find new e-mail address in database**].

Regarding claim 13, Tsuei-Zoken teach the invention substantially as claimed, as aforementioned in claim 12 above, including the steps of deploying a search agent to said generated URI [**Zoken -- Col. 3 lines 23-25 – Generated URI is used to access database site/location and perform the query automatically, i.e. search agent**] and parsing said contact

information of the recipient [**Zoken -- Col. 2 lines 53-58, Col. 3 lines 19-23 and Col. 4 lines 8-9 -- Contact information of recipient in e-mail address is parsed and extracted**].

7. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei (U.S. 6,654,779) and Zoken (U.S. 5,944,787), as applied to claim 6 above, in view of Funk et al. (U.S. 5,937,162).

Regarding claim 8, Tsuei-Zoken teaches the invention substantially as claimed, as aforementioned in claim 6 above, including generating a URI as was shown above. Tsuei-Zoken, however, fails to teach generating an advertisement.

Funk, however, discloses a method for high volume e-mail delivery which inserts a general or targeted advertisement into an e-mail message [**Funk -- Col. 4 lines 3-24 and Col. 10 lines 47-52**].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate advertisements into an e-mail message in order to provide a low-cost system that allows a user to receive unique, customized and personalized information [**Funk -- Col. 3 lines 26-29**].

Regarding claim 9, Tsuei-Zoken-Funk teach the invention substantially as claimed, as aforementioned in claim 8 above, including the step of adding said one of a hyperlink reference, re-direct command, and advertisement to said second message [**Funk -- Col. 10 lines 47-52 --**

Advertisements are inserted into e-mail messages to be delivered to customers based upon the targeted customer base].

8. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei (U.S. 6,654,779), as applied to claim 1 above, in view of Tarbouriech (U.S. 6,674,993).

Regarding claim 16, Tsuei teaches the invention substantially as claimed, as aforementioned in claim 1 above, including notifying the sender that the first recipient address is unknown **[Tsuei -- Figure 4 item 440 and Col. 5 lines 15-33 -- Bounced error message is sent back to sender ISP and deposited in mailbox of sender].**

In addition, Tsuei discloses that information, i.e. an e-mail address link, etc., can be added to a message.

Tsuei fails to teach prompting the sender with possible solutions for finding current contact information of another user.

Tarbouriech, however, teaches that links can be exchanged between users to allow for dynamic information updates by pointing to the location of contact information, which users can periodically refresh as contact information changes **[Tarbouriech -- Col. 13 lines 24-33].**

Therefore, it would have been well known and obvious for one of ordinary skill in the art at the time the invention was made to add information to an e-mail message, i.e. a link, which would prompt the user with a way to obtain updated contact information for another user, as taught by Tarbouriech into the invention of Tsuei, in order to provide for dynamic information exchange

between users such that one user can stay constantly up to date on another users contact information as it changes.

9. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei (U.S. 6,654,779), as applied to claim 1 above, in view of Uhl et al. (U.S. 6,292,709).

Regarding claim 17, Tsuei teaches the invention substantially as claimed, as aforementioned in claim 1 above, but fails to explicitly teach the sender and recipient address is a postal address and the delivery service is a postal service.

Uhl, however, discloses a method and device for online processing of mail items to be forwarded, wherein a sender address and a recipient address are postal addresses to be delivered by a postal service [**Uhl -- Figures 7, 8 and 9 and Col. 8 lines 12-42 -- Pieces of mail containing sender and recipient addresses to be delivered by postal service**].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a postal service and sender/recipient postal addresses, as taught by Uhl into the invention of Tsuei, in order to provide an obvious extension of the system taught by Tsuei to facilitate and simplify the process by which mail at a postal facility gets re-routed if a recipient address is no longer valid.

Regarding claim 18, Tsuei-Uhl teach the invention substantially as claimed, as aforementioned in claim 17 above, wherein said step of adding said access information further

includes the step of selecting from one of a inking said access information to the message and attaching said access information to the message [**Uhl -- Figure 7 and Col. 8 lines 12-24 -- Access information, i.e. new recipient forwarding address, is added to mail by inking in bold red type, new address of recipient**].

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Reilly (U.S. 6,427,164) discloses a system and method for automatically determining if the recipient of an e-mail is unknown and for automatically finding a forwarding address.
- Hitt (U.S. 6,604,132) discloses and system and method for embedding a physical mailing address in an electronic mail address which enables forwarding either electronically or by a convention postal service.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 703-605-1234. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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